

REMARKS

Claims 7-10 and 13-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,914,631 (Guzman). Claims 11-12, 16, and 17-30 stand rejected under Prior Art discussed in Applicants Background (Figure 1) in view of Guzman.

Claims 13 and 19 were amended to correct typographical errors. The features of claims 9, 18, and 28 were incorporated into independent claims 1, 17, and 26, respectively, and were cancelled. Thus, independent claims 1, 17, and 26 include the feature of a joint assembly having securing surfaces that are configured to essentially eliminate singularity points along a joint of the joint assembly. The prior art fails to teach or suggest this feature.

Claim 9 (now incorporated into claim 1) was rejected as being anticipated by Guzman. However, Guzman includes no mention of the problem introduced by singularity points or how to configure a joint to eliminate such singularity points. Moreover, this feature is not inherent in Guzman. Where anticipation is found through inherency, the Office's burden of establishing *prima facie* anticipation includes the burden of providing "...some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987). Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; *see also Skinner*, at 1789. "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987), citing *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981).

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Claims 18 and 28 had been rejected as being obvious over Applicant's teachings in view of Guzman. For the same reasons as provided above for claim 9, Guzman does not teach or suggest singularity-free joints. Applicant's discussion of prior art does not eliminate this defect. The removal of singularities is one of the aspects taught by applicant's invention.

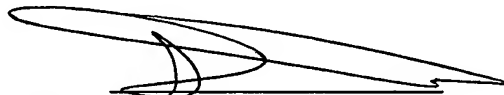
For these reasons, independent claims 1, 17, 26, and all claims depending therefrom are allowable. Applicant respectfully requests these claims be allowed.

In view of the remarks set forth herein, the application is believed to be in condition for allowance and notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to contact the undersigned attorney with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

BORIS A. SHOYKHET

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By: Scott F. Diring
Reg. No. 35,119
Attorney for Applicant
QUARLES & BRADY, LLP
411 East Wisconsin Avenue
Milwaukee, WI. 53202-4497
(414) 277-5711